

## **REMARKS**

### **Claim Rejections**

Claims 1 and 2 are rejected under 35 U.S.C. § 112, second paragraph. Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Li (U.S. 6,848,830). Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto (U.S. 6,196,802) and Saneshige et al. (U.S. 5,145,266).

### **Drawings**

It is noted that the Examiner has accepted the drawings as originally filed with this application.

### **Amendments to Specification**

Applicant has amended the specification as noted above to provide a title more descriptive of the claimed invention. It is believed that the foregoing amendments to the specification overcome the outstanding objections thereto. No "new matter" has been added to the original disclosure by the foregoing amendments to the specification.

### **New Claims**

By this Amendment, Applicant has canceled claims 1-2 and has added new claims 3-4 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward an oil lubricant retaining bearing structure for retaining a lubricant (40) lubricating a fan (20) in a fan housing (30), the oily bearing structure comprising: an oily bearing (10) having: a central axis hole (11),

a fan shaft (21) of the fan being rotatably inserted into the central axis hole; and an internal-recycle oil-retaining system having: an oil collection recess trench (12) formed around an interior surface of the central axis hole; an acute angle oil-guiding ring edge (13, 14) located on each of two opposing ends of the oil collection recess trench; and two round inner recess trenches (15), one of the two round inner recess trenches being formed on each of two opposing ends of the oil collection recess trench adjacent to each acute angle oil-guiding ring edge, wherein the internal-recycle oil-retaining system providing a reservoir for the lubricant.

Another embodiment of the present invention includes: the oily bearing including an upper bearing, a lower bearing spaced apart from the upper bearing a predetermined distance, and an oil-retaining interval located between the upper bearing and the lower bearing and communicating with the oil collection trench.

The primary reference to Li teaches an oil-circulating structure for a fan including an oily bearing (130) having a central axis hole (131), an inner oil-collecting recess trench (134) having an inner thread shape oil-guiding trench (135) formed therein, a first radial through hole (136), and a second radial through hole (137).

Li does not teach an internal-recycle oil-retaining system having an oil collection trench, two round inner recess trenches, and two round inner recess trenches; an acute angle oil-guiding ring edge located on each of two opposing ends of the oil collection trench; one of the two round inner recess trenches being formed on each of two opposing ends of the oil collection trench adjacent to each acute angle oil-guiding ring edge; the internal-recycle oil-retaining system providing a reservoir for the lubricant; nor does Li teach an oil-retaining interval located between the upper bearing and the lower bearing and communicating with the oil collection trench.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Li does not disclose each and every feature of Applicant's new claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Li cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The second primary reference to Matsumoto teaches an axial flow fan and is cited for teaching a two bearings (6, 7). A shaft (8) inserted through the two bearings.

Matsumoto does not teach an internal-recycle oil-retaining system having an oil collection trench, two round inner recess trenches, and two round inner recess trenches; the oil collection trench formed around an interior surface of the central axis hole; an acute angle oil-guiding ring edge located on each of two opposing ends of the oil collection trench; one of the two round inner recess trenches being formed on each of two opposing ends of the oil collection trench adjacent to each acute angle oil-guiding ring edge; the internal-recycle oil-retaining system providing a reservoir for the lubricant; nor does Matsumoto teach an oil-retaining interval located between the upper bearing and the lower bearing and communicating with the oil collection trench.

The secondary reference to Saneshige et al. teaches a bearing apparatus having bearings (12, 22), a bearing holder (5), a sealing cap (6), an oil thrower (7). The bearings have angled interior surfaces (12a, 12a), shown in Figs. 1 and 4. The angled surfaces of the two bearings form a V-shaped chamber when the two bearings are butted against one another.

Saneshige et al. do not teach an internal-recycle oil-retaining system having an oil collection trench, two round inner recess trenches, and two round inner recess trenches; an acute angle oil-guiding ring edge located on each of two opposing ends of the oil collection trench; one of the two round inner recess trenches being formed on each of two opposing ends of the oil collection trench adjacent to each acute angle oil-guiding ring edge; the internal-recycle oil-retaining system providing a reservoir for the lubricant; nor do Saneshige et al. teach an oil-retaining interval located between the upper bearing and the lower bearing and communicating with the oil collection trench.

Even if the teachings of Li, Matsumoto, and Saneshige et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: an internal-recycle oil-retaining system having an oil collection trench, two round inner recess trenches, and two round inner recess trenches; an acute angle oil-guiding ring edge located on each of two opposing ends of the oil collection trench; one of

the two round inner recess trenches being formed on each of two opposing ends of the oil collection trench adjacent to each acute angle oil-guiding ring edge; the internal-recycle oil-retaining system providing a reservoir for the lubricant; nor does the combination suggest an oil-retaining interval located between the upper bearing and the lower bearing and communicating with the oil collection trench.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking

this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Li, Matsumoto, or Saneshige et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Li, Matsumoto, nor Saneshige et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

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**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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By:

  
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